

REMARKS

In the office action mailed April 4, 2005, claims 1-14 and 44-69 were pending. Claims 1, 5-7, 11-14, 44-47, 51-57, 60-69 were finally rejected for various reasons, and claims 2-4, 8-10, 48-50 and 58-59 were withdrawn. Reconsideration of the present application in view of the remarks that follow is respectfully requested.

Claims 1, 5, 7, 11, 14, 44, 45, 47, 51, 54-56, 61 and 64 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,755,797 to Baumgartner. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

It was respectfully submitted in Applicant's September 9, 2005 office action response that Baumgartner does not disclose the claimed arrangement, relationship, and organization of features as recited in the rejected claims. For example, claim 1 is directed to an intravertebral reduction system and recites "a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act one upon the other upon sequential positioning thereof in the intravertebral space thereby compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body."

It was specifically asserted that Baumgartner failed to disclose that the support members provide reduction of cavity 5. In response to this traversal, the Examiner argues that he is looking for "structure limitations that can overcome a prior art [sic]" and that the claim language "thereby" and "wherein" merely state the result of the limitations in

the claims and adds nothing to the patentability or substance of the claim. The Examiner further asserts that Applicant is merely asserting "functional limitations that are of no significance in determining the patentability of the apparatus claim." The office action relies on *Ex parte Thibault*, 14 USPQ 666, 667 (Bd. App. 1969) for not providing patentable weight to functional limitations.

It is respectfully submitted that there is no prohibition to defining claimed structure in the terms of function. See, the Manual of Patent Examining Procedure (MPEP) § 2173.05(g) (citations including, *Innova/Pure Water, Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004) (interpreting functional language in apparatus claims and giving patentable weight thereto)). It is further noted that the MPEP section 2173.05(g) states "[a] functional limitation must be evaluated and considered, just like any other limitation in the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." The MPEP goes on to further to refer to *In re Venezia*, 189 USPQ 149 (CCPA 1974) and recites "[i]n a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' and 'portions ... being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define structural attributes of interrelated component parts of the claimed assembly. "

In addition, the CCPA in *In re Land*, 151 USPQ 621, 635-636 (C.C.P.A. 1966) states "[i]t is true that the italicized portions [of claim 70] are 'functional' but we do not regard that as good ground to give them 'no weight' in view of the third paragraph [currently sixth paragraph] of 35 U.S.C. 112. We give them weight and with the limitation we think claims 70 and 71 are limited to deferred diffusion *built into the structure recited*, thereby being limited to the actual invention disclosed and hence allowable for the same reasons given by the board...." (Emphasis in original).

Furthermore, the case of *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990) involved functional limitations that were assigned patentable weight by the Federal Circuit. In this case, the claims were rejected as obvious because the difference between the claim and the cited references lay "solely" in the functional language of the claims. *Id.* at 1432.

The Federal Circuit reversed on appeal, acknowledging that the difference between the claim and the prior art lay specifically in the functional limitations. Nevertheless, the Federal Circuit held the claim nonobvious over the prior art based on the functional limitations. Id. at 1433. Accordingly, functional language in a claim cannot be ignored for the purposes of patentability, and a prior art reference or combination of references must disclose or suggest the functional limitations of a claim, in addition to the structural limitations, to support a determination of unpatentability.

Likewise, the structural features of independent claim 1 include "a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act one upon the other upon sequential positioning thereof in the intravertebral space thereby compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body." The functional limitations in claim 1 define structural attributes of the reduction elements that are neither disclosed nor suggest the Baumgartner reference since it fails to disclose, teach, or suggest structure to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body.

The Applicant respectfully requests withdrawal of the rejection of independent claim 1 in view of the forgoing arguments. Applicant additionally submits that each of dependent claims 5, 7, 11, and 65-67 are patentable over Baumgartner at least for the reasons provided above for claim 1. Accordingly, withdrawal of this rejection of claims 5, 7, 11, and 65-67 is respectfully requested.

Claim 44 is directed to an intravertebral reduction system and recites "a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements act randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space thereby compressing cancellous bony tissue and applying an outwardly directed corrective force in the intravertebral space to restore the vertebral body."

As discussed above with respect to claim 1, there is no prohibition to defining claimed structure in terms of function. Furthermore, the Baumgartner reference fails to

disclosure, teach, or suggest structure to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body. Therefore, Applicant respectfully requests withdrawal of the rejection of independent claim 44 and each of claims 45, 47, 51, 54, and 68-69 which depend from claim 44, as each is submitted as patentable at least for the reasons supporting the patentability of claim 44.

Claim 55 is directed to "an intravertebral reduction system, comprising a plurality of reduction elements positionable in an intravertebral space adjacent one another in contact with bony tissue, wherein said plurality of reduction elements include exterior surface means for facilitating engagement between adjacent reduction elements and for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body."

As discussed above with respect to claim 1, there is no prohibition to defining claimed structure in terms of function. Furthermore, the Baumgartner reference fails to disclose, teach, or suggest structure for facilitating engagement between adjacent reduction elements and for facilitating said reduction elements acting randomly and radially one upon the other upon sequential positioning thereof in the intravertebral space to compress cancellous bony tissue and apply an outwardly directed corrective force in the intravertebral space to restore the vertebral body." Therefore, Baumgartner fails to disclose every element of independent claim 55 and withdrawal of the rejection thereof is respectfully submitted.

Claims 56, 61, and 64 depending from claim 55 distinguish Baumgartner at least for the reasons provided above for claim 55. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

Claims 6, 46, and 57 were rejected under 35 U.S.C. §103(a) as being unpatentable over Baumgartner. It is respectfully submitted that a prior art reference must teach or suggest all the claim limitations. MPEP § 2142. As discussed above, the Baumgartner reference fails to disclose each of the claim elements of independent claims 1, 44, and 55

from which claim 6, 46, and 57 respectively depend. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. 35 U.S.C. § 112 Fourth Paragraph. Therefore, each of dependent claims 6, 46, 57 include all of the limitations of its base claim and therefore Baumgartner fails to teach or suggest all of the claims limitations of claims 6, 46, and 57, making the 35 U.S.C. § 103(a) rejection improper. Thus, Applicant respectfully requests withdrawal of the rejection of dependent claims 6, 46, and 57.

Claims 12, 13, 52, 53, 60, 62 and 63 were rejected as being unpatentable over Baumgartner in view of U.S. Patent No. 6,620,196 to Trieu. Claims 12 and 13 depend from claim 1, claims 52 and 53 depend from claim 44, and claims 60, 62 and 63 depend from claim 55. Accordingly, claims 12, 13, 52, 53, 60, 62 and 63 are allowable at least because the claim from which each depends is allowable as asserted herein above.

Reconsideration of the present application including claims 1, 5-7, 11-14, 44-47, 51-57, and 60-69 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted

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